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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/507,103	09/10/2004	Yoel Sasson	SASSON3	2096
1444 7590 05/28/2008 BROWDY AND NEIMARK, P.L.L.C. 624 NINTH STREET, NW SUITE 300 WASHINGTON, DC 20001-5303				
EXAMINER				
PURDY, KYLE A				
ART UNIT		PAPER NUMBER		
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/507,103

Applicant(s)

SASSON ET AL.

Examiner

Kyle Purdy

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Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 September 2004 and 21 April 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) 1-14 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 15-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/5508)
Paper No(s)/Mail Date 3 sheets (09/10/2004 and 03/22/2005)
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Election Acknowledged

1. Applicant's election with traverse of the invention of Group II encompassing claims 15-25 in the reply filed on 04/21/2008 is acknowledged. The traversal is on the ground(s) that the reference applied to break unity (Yoshida *et al.*, JP2000-186001) is insufficient because (A) Yoshida is drawn to antimicrobial/fungicidal compositions in the field of human health which is different from the instant application and that (B) the lactate esters used in the present invention are not merely used as organic solvents as they are in the reference. Applicants arguments are respectfully not found persuasive. With respect to A, it is not clear how Applicant is distinguishing between the reference and the instant application. For one, the claims of the present application recite a pesticidal composition which defines the pesticide as being a triazole (e.g. epoxiconazole, tebuconazole, etc.) which are known antifungals. With respect to B, if the lactate ester is not used as a solvent (or co-solvent) in the instant application then what is it used for? While it may be true that the lactate ester is included in the composition for its crystal preventive properties, the fact remains that it is included and would serve as a solvent. Regardless, the fact that Yoshida uses lactate esters as a solvent does not lessen its validity in breaking unity because the mere inclusion of the ester, whether as primary solvent or not, would be sufficient to prevent crystal growth.

2. The requirement is still deemed proper and is therefore made FINAL.

Status of Application

3. Claims 1-25 are pending, claims 1-14 are withdrawn and claims 15-25 are presented for examination on the merits. The following rejections are made

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 17, 21, 23 and 24 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

6. Claims 17, 21, 23 and 24 each recite the term “rosin derivative”. The term ‘derivative’ makes it impossible to comprehend the scope of the instant claims. To what degree of derivitization upon the rosin would the derivative no longer be considered a derivative? As is currently written, it would be impossible for someone skilled in the art to be capable of envisioning all the limitations of the instant claims. Clarification is required.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 15, 16, 20 and 22 rejected under 35 U.S.C. 102(b) as being anticipated by Aven (WO 00/18227; of record, see IDS).

9. Aven is drawn to non-aqueous suspension concentrates. Example M teaches a composition which comprises a pesticide (Compound 1B) and a lactate ester (2-ethyl hexyl

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lactate) at 100 g and 290 g, respectively. The weight ratio between the pesticide and the lactate is 3.5:1 which anticipates the instantly claimed weight ratio of 1:0.1 (10:1).

10. With respect to the functions recited, (i.e. crystal growth inhibitor) any properties exhibited by or benefits provided by the composition are inherent and are not given any patentable weight over the prior art. A chemical composition and its properties are inseparable. If the prior art includes an identical compound in their composition, the properties that applicant discloses and/or claims are necessarily present in the reference. The disclosed functions within the instant application does not render the use of lactate esters as crystal growth inhibitors patentably distinct over the prior art.

11. Thus, the teaching of Aven anticipates the instantly rejected claims.

Claim Rejections - 35 USC § 103

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. Claims 15, 16, 19, 20 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Aven (WO 00/18227; of record, see IDS).

14. Aven is relied upon for disclosure described in the rejection of claim 15, 16, 20 and 25 under 35 U.S.C. 102(b).

15. Aven discloses that the pesticide in the composition may be an antifungal selected from, among others, epoxiconazole, metaconazole and cyproconazole (see page 4; see instant claim 19).

16. Thus, it would have been obvious to one ordinarily skilled in the art to use and modify the teaching of Aven with a reasonable expectation for success in arriving at a pesticidal composition comprising a lactate ester wherein the pesticide is an antifungal such as epoxiconazole. Although Aven does not specifically teach a composition comprising one of the components, it would have been within the purview to one of ordinary skill to arrive at a formulation wherein the final composition comprises a lactate ester and epoxiconazole (or metaconazole or cyproconazole). Therefore, the invention as a whole is *prima facie* obvious to one ordinary skill in the art at the time the invention was made, as evidenced by the references, especially in absence of evidence to the contrary.

17. Claims 15-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Aven (WO 00/18227; of record, see IDS) in view of Lichti et al. (US 5403813), evidenced by Rosin (gum) MSDS.

18. Aven is relied upon for disclosure described in the rejection of claims 15, 16, 20 and 22 under 35 U.S.C. 102 (b) and claims 15, 16, 19, 20 and 22 under 35 U.S.C. 103(a).

19. Aven fails to include a rosin derivative in their pesticidal composition.

20. Lichti *et al.* ('Lichti) is drawn to controlled release composition of a biocide in an aqueous dispersion of viscous oil. The composition comprises 1) a viscous oil which includes derivatives of abietic acid, especially wood rosin and its derivatives especially those with an

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ester functionality (see column 3, lines 30-40; see instant claim 17 and 18) and 2) at least one active ingredient such as fungicide or insecticide (see abstract). The Examples of Lichti comprise Chinese rosin and its inclusion in the compositions range from 6.2% to 8.7% by weight (see Examples 8 and 17; see instant claims 21, 24 and 25). Further, the weight ratio of the pesticide (trifluralin) to rosin in Example 8, for instance, is 2:1 which falls within the instantly cited range (see instant claim 23).

21. Thus, it would have been obvious to one ordinarily skilled in the art at the time the invention was made to combine the teachings of Aven with Lichti with a reasonable expectation for success in arriving at a pesticidal composition comprising a lactate ester, a pesticide and a rosin derivative. The importance of Lichti is that they teach combining rosin and rosin derivatives have useful application in pesticidal/fungicidal compositions. It is taught that the rosin compounds are useful because they act to create a composition with sustained release properties. Moreover, the rosin compounds are highly viscous which would enable greater exposure time to the surface applied leading to lengthened pesticidal activity. Albeit Aven does not teach using lactate esters in their composition, it would have been obvious to one of ordinary skill in the art to combine the teaching with Aven and arrive at the currently claimed invention. According to the MPEP (2144.06), it is *prima facie* obvious to combine to compositions each of which is taught by the prior art to be useful for the same purpose, in order to form a third composition to be used for the very same purpose. So the fact that both compositions are directed to application of pesticidal compositions, one of ordinary skill would have been motivated to combine them with a reasonable expectation for success in arriving at a composition with the instantly claimed properties.

22. Note: rosin and rosin gum have been interpreted to be the same thing. According to the MSDS sheet for rosin, it appears to be chemically equivalent to rosin gum (i.e. rosin (gum)). However, in the case that they are not chemically equivalent, the MSDS sheet would obviate one over the other.

Conclusion

23. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kyle A. Purdy whose telephone number is 571-270-3504. The examiner can normally be reached from 9AM to 5PM.

24. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Woodward, can be reached on 571-272-8373. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

25. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

*/Kyle Purdy/
Examiner, Art Unit 1611
May 21, 2008*

***/MP WOODWARD/
Supervisory Patent Examiner, Art Unit 1615***